

The opinion in support of the decision being entered today was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS FRUH, LUDGER HEILIGER,
and
GIORGIO E. MULLER

MAILED

AUG 26 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-0875
Application No. 09/736,593

ON BRIEF

Before WALTZ, TIMM, and PAWLIKOWSKI, *Administrative Patent Judges*.
TImm, *Administrative Patent Judge*.

DECISION ON APPEAL

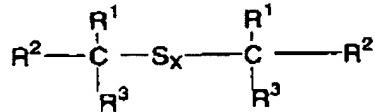
This appeal involves claims 4-11 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

Claims 4-11 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 3,354,131 issued November 21, 1967 to Trivette et al. (Trivette). The Examiner's reasoning is set forth in the Office Action mailed December 1, 2003 (Answer, p. 2).

Appellants state that the claims stand or fall together (Brief, p. 3). We select claim 4 to represent the issues on appeal. Claim 4 reads as follows:

4. A method for the mastication of rubbers comprising the step of mixing said rubbers with a dialkyl polysulfide and optionally rubber chemicals and/or fillers, wherein said dialkyl polysulfide is a polysulfide of the formula



wherein

R^1 to R^3 are identical or different and represent a linear or branched C_1-C_{18} -alkyl radical or represent hydrogen and
 x represents the numbers 3 to 5.

We affirm substantially for the reasons advanced by the Examiner in the Answer and in the Office Action mailed December 1, 2003 referred to in the Answer (Office Action). We add the following primarily for emphasis.

OPINION

There is no dispute here that, as found by the Examiner, Trivette describes mixing rubbers with a dialkyl polysulfide as required by the only method step recited in claim 4 (Office Action, pp. 2-3). The Examiner acknowledges that Trivette does not identify the process as one “for the mastication of rubbers” as recited in the preamble of claim 4 (Office Action, p. 3). Trivette, rather, describes adding the dialkyl polysulfide for the purpose of inhibiting the pre-vulcanization of the rubber containing compositions (*Id.*). The Examiner’s conclusion of unpatentability rests upon the determination that it is reasonable to believe that the processing of the same ingredients by the same method results in the same function, i.e., mastication (Office Action, p. 3). Or, as stated in the Examiner’s Answer, “it is reasonable to presume that the polysulfide of the prior art when mixed with the rubbers of the prior art would have a masticating effect on the rubber.” (Answer, p. 4).

Appellants argue that Trivette adds dialkyl polysulfide during or subsequent to vulcanization and, therefore, the dialkyl polysulfide could not have a mastication effect because during vulcanization cross-linking of the rubber takes place, which is the opposite of a masticating effect (Brief, p. 4). According to Appellants, a masticating agent is added to a rubber

mixture to soften the rubber thereby making the rubber more processable and during mastication the main chain of the rubber compound is broken down (*Id.*).

Both the Examiner's rejection and the Appellants' arguments assume that the language "for the mastication of rubbers" in claim 4 breathes life and meaning into the claim to the extent that the claim requires that mixing result in a masticating effect on the rubber. The dispositive question, as framed by this claim interpretation, is whether the masticating effect is inherently present in the method of Trivette.

As stated in *In re Best*, 562 F.2d 1252, 1254-55, 195 USPQ 430, 433, *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) set forth the burden of proof required to overcome an inherency rejection:

[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [439 F.2d at 212-13, 58 CCPA at 1031, 169 USPQ at 229.]

As further conveyed in *Best*: "Whether the rejection is based on 'inherency' under 35 U.S.C. § 102, on 'prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products." 562 F.2d at 1255, 195 USPQ at 433-434 (footnote omitted).

We conclude that the Examiner's assertion of inherency under 35 U.S.C. § 102, or of prima facie obviousness under 35 U.S.C. § 103 is reasonable and that the burden in rebuttal has not been met. The Examiner finds, and Appellants do not dispute, that Trivette describes mixing the claimed dialkyl polysulfide and rubbers in accordance with the only step of the claimed process. In such a situation, it is reasonable to conclude, based on the identical nature of the starting materials and the processing conditions, that the claimed effect inherently occurs. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433-34 (CCPA 1977); *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82-83 (CCPA 1975). Appellants' arguments do not convince us otherwise. According to Appellants, dialkyl polysulfide could not have a mastication effect because vulcanization crosslinking occurs in the process of Trivette (Brief, p. 4). The argument is not convincing because, in the process of Trivette, dialkyl polysulfide is mixed into the rubber prior to vulcanization. One purpose of mixing the dialkyl polysulfide into the rubber, in fact, is to prevent vulcanization crosslinking of the rubber composition during the usual processing steps prior to the final vulcanizing step (col. 1, ll. 22-28). Trivette states that, even in the presence of sulfur-vulcanizing agent, the polysulfides "remarkably inhibit pre-vulcanization." (col. 2, ll. 11-15). Because rubber and dialkyl polysulfide are mixed before vulcanization in the process of Trivette, it is reasonable to believe that mastication occurs at that point in the process. Because the PTO does not have the testing facilities necessary to determine if, in fact, the inherent characteristic is, indeed, present, the burden shifts to the applicant to prove that the

subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Best*, 562 F.2d at 1255, 195 USPQ at 434. Appellants have not provided a sufficient level of evidence, such as test results, to overcome their burden.

We conclude that the Examiner has established a *prima facie* case of unpatentability with respect to the subject matter of claims 4-11 which has not been sufficiently rebutted by Appellants.

We note that, in the Response to Argument section of the Answer, the Examiner states that “[t]he language ‘for the mastication of rubbers’ is not seen to be limiting, but rather an intended result obtained by the physical step of mixing the rubber and the polysulfide compound.” (Answer, p. 3). Appellants provide no response to this alternative claim interpretation; there is no reply brief of record. The question here is: Can the process step within the body of the claim stand alone or does the claim depend on the preamble for completeness?

In re Hirao, 535 F.2d 67, 70, 190 USPQ 15, 16-17 (CCPA 1976). If the body of the claim sets out the complete invention, and the preamble is not necessary to give “life, meaning and vitality” to the claim, “then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.” *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001)(quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1166 (Fed. Cir. 1999)).

Giving claim 4 its broadest reasonable interpretation consistent with the specification and reading the claims in light of the specification as it would be interpreted by one of ordinary skill

in the art, *see In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 70 USPQ2d 1827, 1830 (Fed. Cir. 2004), we determine that “for the mastication of rubbers” merely sets forth the purpose or intended use of the claimed method. The claim does not affirmatively require that mastication *actually* occur in the process, it only conveys an *intention* that mastication occur. Moreover, the body of the claim does not refer to mastication and this suggests that the mastication aspect of the preamble is independent from the body of the claim. We, therefore, find that the Examiner’s broader reading of the claim is not unreasonable. Under these circumstances, because, as undisputed by Appellants, Trivette describes mixing the claimed rubbers with the claimed dialkyl polysulfide, claim 4 is anticipated by Trivette regardless of whether mastication occurs in the mixing process of Trivette. Anticipation, if course, is the ultimate of obviousness. *See In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

CONCLUSION

To summarize, the decision of the Examiner to reject claims 4-11 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Thomas A. Waltz
THOMAS A. WALTZ)
Administrative Patent Judge)
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Catherine Timm
CATHERINE TIMM) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)

Beverly A. Pawlikowski
BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

LANXESS CORP.
111 RIDC PARK WEST DRIVE
PITTSBURGH, PA 15275-1112